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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,398	05/10/2005	Craig Gregory Smith	18155-002US1	9329

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FISH & RICHARDSON, PC  
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MINNEAPOLIS, MN 55440-1022

EXAMINER
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RAPILLO, KRISTINE K

ART UNIT	PAPER NUMBER
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3626

NOTIFICATION DATE	DELIVERY MODE
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06/23/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/508,398	<b>Applicant(s)</b> SMITH ET AL.	
	<b>Examiner</b> KRISTINE K. RAPILLO	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/20/2004; 1/22/2007</u> .                                    | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### **Notice to Applicant**

1. This communication is in response to the application filed September 20, 2004. Claims 1 - 23 are pending.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "person" is not clearly defined; person could be interpreted as a patient or healthcare provider (i.e. physician, nurse). For examination purposes, the term "person" will be treated as a healthcare provider. The phrase "instant in time" is unclear. For the purpose of examination, "instant in time" will be treated as simply time as the interpretation of the phrase "instant in time" is subjective.

4. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A privacy protection layer is unclear and is not clearly defined in the specification. For the purpose of examination, the phrase "privacy protection layer" will be treated as a security feature.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1 – 6 and 8 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson et al., herein after Richardson (U.S. Publication Number 2003/0225596 A1) in view of Frederick (U. S. Patent Number 6,788,997).

In regard to claim 1 (Original), Richardson teaches a computerised identity matching management process for the supply of a pharmaceutical substance to an authorised person, the process comprising the steps of:

identifying a person who is requesting the supply of the substance (paragraphs [0056] and [0057] where biometric identification is performed to process the identity of the user), comprising the steps of:

a management computer receiving a request, from capture apparatus waiting to commence a biometric capture process representative of the person to initiate the capture process (paragraphs [0032] and [0060] where a provider (i.e. physician, nurse) carries or wears an identification key with their biometric identity stored on it.. The key will activate a biometric scanner within a certain distance of the scanner. The provider, using a biometric scanner, will scan in; if the identification key and the new scan match the user is allowed access. Thus, the request is equated to the identification key activating the biometric scanner);

the management computer responding to the request to return a message to the capture apparatus at a first instant in time (paragraphs [0028], [0030], [0057], and [0058]) the message containing a unique code (paragraphs [0028], [0030], [0057], and [0058]), and where receipt of the message containing the code at the capture apparatus causes initiation of the capture process (paragraphs [0028], [0030], [0057], and [0058]);

the management computer, after returning the message, receiving a captured biometric representative of the person from the capture apparatus coded with the code, at a second instant in time (paragraphs [0032], [0057], and [0058]); and

the management computer operating, when the second instant is less than a predetermined time later than the first instant (paragraphs [0028], [0032], and [0058]) to decode the captured biometric (paragraphs [0028] and [0032] where decode is equated to reading the biometric scan) and initiate a

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matching process to find a match for the decoded captured biometric against stored biometric records and to retrieve an identification code representative of the person when a match is found (paragraphs [0030] and [0032]).

retrieving a date stamp and using the identification code to retrieve a stored data record of the person (paragraphs [0034], [0036], and [0038]) which includes at least a substance the person is prescribed (paragraph [0039]) and a quantity in which the substance is to be supplied (paragraph [0039]).

Frederick teaches a process comprising the steps of:

retrieving a date stamp and using the identification code to retrieve a stored data record of the person which includes a date at which the substance is to be supplied (Figure 30; column 20, lines 29 – 43; column 42, lines 6 – 12; and, column 56, lines 45 – 60);

determining whether the date stamp matches the date at which the substance is to be supplied (Figure 30; column 20, lines 29 – 43; column 42, lines 6 – 12; and, column 56, lines 45 – 60), and

if a match is determined, supplying the substance in the prescribed quantity and recording information to form a record to update the supply of the substance to the person (Figure 39; column 9, lines 38 – 59; column 42, lines 66 – 67; column 43, lines 44 – 61; and column 46, lines 48 – 65).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a process comprising the steps of: to decode the captured biometric and initiate a matching process to find a match for the decoded captured biometric against stored biometric records and to retrieve an identification code representative of the person when a match is found; retrieving a date stamp and using the identification code to retrieve a stored data record of the person which includes a date at which the substance is to be supplied; determining whether the date stamp matches the date at which the substance is to be supplied, and if a match is determined, supplying the substance in the prescribed quantity and recording information to form a record to update the supply of the substance to the person as taught by Frederick, within the process of Richardson, with the motivation of providing a tool to manage the inventory of medicine and tracking who has dispensed the medicine (column 2, lines 33 - 65).

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In regard to claim 2 (Original), Richardson and Frederick teach the process according to claim 1. Richardson teaches a process where the biometric records are securely stored within the management computers cache (paragraphs [0013] and [0058]) where Richardson discloses an encrypted electronic identification key with biometric matching stored in memory.

In regard to claim 3 (Original), Richardson and Frederick teach the process according to claim 1 or 2. Richardson teaches a process where the stored data records are logically separate from the biometric records (paragraph [0042]) where the records can be stored in one location.

In regard to claim 4 (Currently Amended), Richardson and Frederick teach the process according to claim 1. Richardson teaches a process where the stored data records are physically separate from the biometric records (paragraph [0042]) where the records can be stored apart from one another.

In regard to claim 5 (Currently Amended), Richardson and Frederick teach the process according to claim 1. Richardson teaches where the matching process includes generating a template image of the decoded captured biometric for matching against stored biometric records (paragraph [0062]) where Richardson discloses a digital identification technique which includes recording an encrypted digital template.

In regard to claim 6 (Original), Richardson and Frederick teach the process according to claim 5. Richardson teaches a process where the stored biometric records include a biometric enrol template of the left iris, a biometric enrol template of the right iris, and the identification code (paragraph [0058]) where Richardson discloses a biometric profile in which iris scanning is performed to identify a user.

In regard to claim 8 (Currently Amended), Richardson and Frederick teach the process according to claim 1. Richardson teaches a process where the stored data records include a patient database (paragraph [0033]) and a prescriber database (paragraphs [0031] and [0060]).

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In regard to claim 9 (Original), Richardson and Frederick teach the process according to claim 8.

Frederick teaches a process where the stored data records further include a drug register database (column 19, line 53 through column 20, line 10) and a supplier database (column 19, line 53 through column 20, line 10).

The motivation to combine the teachings of Richardson and Frederick is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 10 (Currently Amended), Richardson and Frederick teach the process according to claim 1. Richardson teaches a process further including the step of enrolling a person into a program so that the person is authorised to receive the substance (paragraphs [0029], [0030], and [0032]) where a fingerprint is used to identify a user, thus performing the act of enrolling or authorizing.

In regard to claim 12 (Original), Richardson and Frederick teach the process according to claim 11.

Frederick teaches the process wherein prior to storing a biometric record of the captured biometric, the management computer performing a fraud check to ensure the person is not already enrolled on the system (column 66, lines 34 – 47).

The motivation to combine the teachings of Richardson and Frederick is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 13 (Original), Richardson and Frederick teach the process according to claim 11 or claim 12. Richardson teaches a process wherein having decoded the captured biometric, the management computer transforming the captured biometric into an enrolment template in order to store a biometric record of the person's captured biometric (paragraphs [0011], [0028], [0030], and [0041]).

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In regard to claim 14 (Currently Amended), Richardson and Frederick teach the process according to claim 1 or 11. Richardson teaches a process where the predetermined time is determined according to the time required for the biometric capture process (paragraph [0012]) where the biometric matching is performed in less time as fewer matches are required.

In regard to claim 15 (Currently Amended), Richardson and Frederick teach the process according to claim 1. Richardson teaches a process where the substance is a controlled substance (paragraphs [0010] and [0039]).

In regard to claim 23 (Currently Amended), Richardson and Frederick teach the system according to claim 18. Richardson teaches a system further comprising a privacy protection layer between the management computer and at least the capture apparatus (paragraphs [0058] and [0063]).

Process, method, and system claims 11 and 16 – 22 repeat the subject matter of process claims 1, 3 – 4, and 8 - 9. As the underlying processes of claims 1, 3 – 4, and 8 – 9 have been shown to be fully disclosed by the teachings of Richardson and Frederick in the above rejections of claims 1, 3 – 4, and 8 - 9; as such, these limitations (11 and 16 – 22) are rejected for the same reasons given above for claims 1, 3 – 4, and 8 – 9 and incorporated herein.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson et al., herein after Richardson (U.S. Publication Number 2003/0225596 A1) in view of Frederick (U. S. Patent Number 6,788,997) as applied to claim 6 above, and further in view of Meadows (U.S. Publication Number 2002/0116390 A1).

In regard to claim 7, Richardson and Frederick teach the process according to claim 6.

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Meadows teaches a process where the stored biometric records further include a portrait image of the person (paragraph [0045]). Although Meadows' invention is for the identification of dogs, the concept of adding a photo or portrait to the biometric record would be the same if applied to humans.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a process where the stored biometric records further include a portrait image of the person as taught by Meadows, within the process of Richardson and Frederick, with the motivation to provide a tool to aid, and confirm the identification of a healthcare provider and/or patient (paragraph [0009]).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wallace et al. (U.S. Patent Number 6,564,121) discloses a system and method for drug dispensing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 4 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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KKR

/C. Luke Gilligan/  
Supervisory Patent Examiner, Art Unit 3626